

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHOICHI ISHIZAWA and KYOICHI IDENO

Appeal No. 1999-0891
Application No. 08/676,484

ON BRIEF

Before HAIRSTON, JERRY SMITH, and BARRY, Administrative Patent Judges.

BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the rejection of claims 15-22 and 24-26. We reverse.

BACKGROUND

The invention at issue is a laptop computer. The computer includes a body featuring a keyboard. A display frame supporting a screen is pivotally mounted through a hinge at the rearmost end of the base to cover the keyboard when

closed. Speakers are built-in to the frame at both sides of the screen.

Claim 26, which is representative for present purposes, follows:

26. An electronic information apparatus comprising:

(a) a keyboard having a plurality of input keys provided at an upper surface of the keyboard,

(b) a display element pivotally mounted on the keyboard by a hinge, the display element comprising:

(1) a display element body, and

(2) a frame supporting and surrounding the display element body, the frame having one pair of speakers therein, the speakers being separated by the display element body and arranged along a rotation axis of the display element.

The prior art applied in rejecting the claims follows:

Frey et al. (Frey) 4,483,634 Nov. 20, 1984

Sherman et al. (Sherman) 4,808,017 Feb. 28, 1989

Morris, Int'l Publication No. WO 91/04461, Apr. 4, 1991

Tsukizoe, Japanese Published Patent Application 02-
209100, Aug. 20, 1990¹.

The examiner rejects claims 15, 20, and 24-26 under 35 U.S.C. § 103 as being obvious over Morris in view of Tsukizoe. He also rejects claims 16-19 under § 103 as being obvious over Morris in view of Tsukizoe further in view of Frey and claim 22 under § 103 as being obvious over Morris in view of Tsukizoe further in view of Sherman. Rather than reiterate the arguments of the appellants or examiner in toto, we refer the reader to the briefs and answer for the respective details thereof.

OPINION

After considering the record, we are persuaded that the examiner erred in rejecting claims 15-22 and 24-26. Accordingly, we reverse. We begin by considering the examiner's rejection and the appellants' argument.

¹A copy of the translation prepared by the U.S. Patent and Trademark Office is attached. We will refer to the translation by page number.

The examiner asserts, "it would have been obvious ... to have incorporated **Tsukizoe Koichi's** pair of speakers into Morris's display system since this is an advancement for Morris computer device [sic] to provide efficiency and convenience for a blind user to hear the output from the system." (Final Rejection² at 3.) The appellants argue, "that the examiner can imagine a reason for incorporating the secondary reference's stereophonic speaker system and placement into the '461 patent does not impact upon the obviousness question." (Reply Br. at 8.)

Claims 15-22 and 24 specify in pertinent part the following limitations: "one pair of speakers at both sides of the display element, the speakers being arranged along a rotation axis of the display element and being physically separated from each other at a predetermined space" Similarly, claim 25 specifies in pertinent part the following

²"[A]n examiner's final rejection, which precipitates the statutory right to appeal to the Board, 35 U.S.C. §134 (1988), constitutes the 'decision' of an examiner for purposes of §1.196(a)." In re Webb, 916 F.2d 1553, 1556, 16 USPQ2d 1433, 1435 (Fed. Cir. 1990)(citing In re Bush, 296 F.2d 491, 492, 131 USPQ 263, 264 (CCPA 1961)).

limitations: "one pair of speakers provided on the frame so that the speakers are separated by the display element body, the speakers being arranged along a rotation axis of the display element." Also similarly, claim 26 specifies in pertinent part the following limitations: "a frame supporting and surrounding the display element body, the frame having one pair of speakers therein, the speakers being separated by the display element body and arranged along a rotation axis of the display element." Accordingly, claims 15-22 and 24-26 require inter alia a pair of speakers arranged along a rotation axis of a display element with one speaker at each side of the element.

The examiner fails to show a teaching or suggestion of the limitations in the applied prior art. Morris teaches that "[p]ortable computer 10 includes a housing having first and second compartments 12 and 14 connected by hinge means 16 for pivoting the compartments to relative open and closed positions as is well known in the art. [M]eans such as detachable liquid crystal display screen 18 displays information from the computer when the compartments are in the

open position" P. 3, ll. 26-32. "[C]omputer 10 also includes a microphone and a speaker such as pop-up speaker phone 50" P. 5, ll. 1-3. The examiner admits, "Morris has failed to disclose having a pair of speakers at both sides of the display." (Final Rejection at 3.) For its part, Tsukizoe teaches "two speakers placed at the left and right sides of an image display device such as CRT and stereo sound output device that outputs sound from these speakers" Tsukizoe Translation, p. 3.

The examiner fails to identify a sufficient suggestion to combine the teachings of the references. "[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)). "Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicants." Id., 55 USPQ2d

at 1316 (citing In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

Here, Morris' computer already includes a speaker as aforementioned. Incorporating Tsukizoe's speakers into the computer would have been redundant. Because incorporating the additional speakers would have added bulk, moreover, it would have been contrary to industry's trend toward "miniaturization of ... electronic information equipment" (Spec. at 2.) Neither the addition of Frey nor Sherman cures the defect of the proposed combination. Because there is no evidence that incorporating the additional speakers into Morris' computer would

have been desirable, we are not persuaded that teachings from the applied prior art would have suggested the limitations of "one pair of speakers at both sides of the display element, the speakers being arranged along a rotation axis of the display element and being physically separated from each other at a predetermined space;" "one pair of speakers provided on the frame so that the speakers are separated by the display

element body, the speakers being arranged along a rotation axis of the display element;" or "a frame supporting and surrounding the display element body, the frame having one pair of speakers therein, the speakers being separated by the display element body and arranged along a rotation axis of the display element." Therefore, we reverse the rejection of claims 15, 20, and 24-26 as being obvious over Morris in view of Tsukizoe, of claims 16-19 as being obvious over Morris in view of Tsukizoe further in view of Frey, and of claim 22 as being obvious over Morris in view of Tsukizoe further in view of Sherman.

CONCLUSION

In summary, the rejection of claims 15-22 and 24-26 under § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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